

REMARKS

In the Office action mailed September 22, 2005, the examiner objects to claim 10 and rejects claims 1-17. This reply amends claim 10. As such, claims 1-17 are pending and under consideration.

I. Response to objections

The examiner objects to claim 10. This reply responds to the objection by amending the claim.

II. Response to § 103 rejection of claims 1-16

The examiner rejects claims 1-17 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,327,578 ("Linehan") in view of U.S. Patent No. 5,761,308 ("Torii"). These rejections are respectfully traversed for the following reasons.

A. Failure to teach or suggest all limitations

1. Claims 1-16: Claim 1 recites "security information comprising information regarding a design error or bug in a computer program". The examiner acknowledges that Linehan does not teach this feature on page 5 of the action. However, the examiner asserts that Torii "discloses a user storing an installation history file (security information) comprising design error or bug . . . in a software . . . (column 10, lines 24-65)".

Torii is directed to a system for software vendors who refund the price of software when a purchaser can't install the software on his machine. Specifically, Torii describes methods for preventing users who properly install software from receiving a refund from the vendor. To accomplish this, Torii teaches monitoring a user while the user attempts to install software. Specifically, when a user begins to install software, an "installation state monitoring unit" writes a "start code" in an installation history file (col. 8, ll. 4-10). If the installation completes, a "termination code" is recorded in the installation history file.

When a user requests a refund, the user must send the installation history file to the software vendor. If the history file has a start code and a termination code, the vendor knows the user successfully installed the software, and the vendor can properly deny the refund. However, if the history file has a start code but lacks a termination code, the vendor knows the

user did not install the software, and the vendor would refund the price of the software to the user.

Information regarding whether software installed on a machine bears no relation to "a design error or bug in a computer program". As such, a file containing only a "start code" and a "termination code" does not correspond to this feature of claim 1.

Claims 8, 15, and 16 are not unpatentable over Linehan in view of Torii at least because each claim includes a limitation similar to the limitation discussed above. Claims 2-7 and 9-14 are not unpatentable over Linehan in view of Torii at least because each claim depends upon an allowable base claim.

2. Claim 17: Claim 17 recites "information . . . regarding a security flaw in a product." The applicants fail to understand how software installation information could possible relate to "a security flaw in a product". If the examiner continues to make this assertion, the applicants respectfully request the examiner to explain where and how Torii discusses a "security flaw" and, more specifically, how an installation "start code" and an installation "termination code" can possible relate to "a security flaw in a product".

B. Lack of motivation to combine

The examiner rejections of claims 1-17 are also improper because the examiner failed to articulated a proper reason to modify Linehan in view of Torii.

To establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

MPEP § 2143.

Linehan describes a method of paying a merchant for a purchase by a consumer. The method involves exchanging communications between the consumer, the merchant, the consumer's bank, and the merchant's bank. The teachings of Linehan are designed to simplify paying for a product purchased over a network while maintaining adequate security.

The examiner asserts that one would have modified Linehan to provide "a secure transaction by making sure that the user has proper right of receiving the money, and also a fair transaction by allowing both parties such as the consumer and the software provider to benefit from the transaction." This motivation is improper because, first, Linehan already provides "a secure transaction". In fact, providing a secure transaction is the exact purpose of the system

described by Linehan. As Torii teaches a system that is less secure than the system of Linehan, there is no reason to apply the teachings of Torii to Linehan.

Second, Linehan already makes sure that a user has proper right to receive money. Again, that is the primary purpose of Linehan. Specifically, to ascertain that a merchant has proper right to receive money, Linehan explains that a bank "verifies the merchant's signature to prove that the consumer is dealing with the actual merchant and validates the merchant's certification and the acquirer's certificate to prove that the merchant and issuer share a common financial arrangement" (col. 6, ll. 8-12).

Because Linehan already presents a system that provides "a secure transaction" and "a fair transaction", the examiner's motivation must be incorrect. As such, the examiner fails to articulate a proper reason for modifying Linehan, and the rejection is improper.

III. Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with the filing of this reply, please charge them to Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Jan. 23, 2006

By: Shin Gai
E. F. Gain Jr.
Registration No. 55,917

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501